

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Real-E Studios, LLC
Appl. No.: 10/828,517
Filed: April 19, 2004
Docket No.: 2057
Conf. No.: 4284
Title: **METHOD, SYSTEM, AND COMPUTER-READABLE MEDIUM
FOR CREATING ELECTRONIC LITERARY WORKS,
INCLUDING WORKS PRODUCED THEREFROM**

Art Unit: 2176
Examiner: James J. Debrow

Action: **RESPONSE TO OFFICE ACTION**
Date: May 26, 2009

TO: Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REMARKS

Sir:

The present communication is in response to the final office action dated November 24, 2008 in reference to the above-identified application. Filed concurrently herewith is a request for a three-month extension of time so that the present response is due by May 24, 2009 (a Sunday), which is followed by a Federal holiday (Memorial Day). As such, this response is due Tuesday, May 26, 2009. Also filed concurrently herewith is a Request for Continued Examination (RCE) pursuant to 37 C.F.R. §1.114 along with the fee set forth in 37 C.F.R. §1.17(e) in order to timely submit declarations under 37 C.F.R. §1.131 as provided for under MPEP §715.09(D).

In the final office action, claims 1-43 are pending. Each of these claims is rejected under 35 U.S.C. §103(a) as being unpatentable over MS Word in view of

Lazareck et al. (Pub. No. US 2007/0011607 A1), and further in view of Nara et al. (US Patent No. 7,203,900 B2). The Lazareck reference has an effective date of February 7, 2003.

Applicant's earlier response was accompanied by a first declaration of Ed Seeman under 37 C.F.R. §1.131 (the "1st Seeman Decl."). Attached as Exh. A to the First Seeman Decl. was a copy of a "General Contract for Software Development" that was entered into on November 18, 2002 between Real-E Studios and an independent contractor. This software development contract was accompanied by a project description which was attached as Exh. B to the 1st Seeman Decl. As set forth in Applicant's earlier reply, there were numerous features described in detail in Exh. B to the 1st Seeman Decl. including an archive image set, the generation of a contact sheet view comprising an imported image set, the establishment of a working image set through population of a second working area of the application program with selected digital images, the arrangement of digital images from the working image set into a selected storyboard sequence, the association of respective image data with images from the working image set to define pairs of companion image items, and the display of the companion image set according to the storyboard sequence.

In the final office action, the Examiner does not make an explicit determination as to whether the evidence previously submitted establishes conception prior to February 7, 2003. However, there can be no question that this is the case, and it is submitted that every claimed feature is described in detail in Exh. B to the 1st Seeman Decl. It is, thus, respectfully requested that the Examiner now make an explicit finding in this regard.

Further evidence of reduction to practice of the invention is provided by this reply. Such evidence includes a second declaration of Mr. Ed Seeman (the “2nd Seeman Decl.”) and a declaration of the undersigned (the “Henson Decl.”). This evidence, in conjunction with that previously submitted, establishes a “. . . conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.” See MPEP §715. More particularly, the various affidavits collectively evidence establish conception of the invention prior to the effective date of Lazarek (*See* 1st Seeman Decl.) coupled with due diligence from prior to said date to the filing of the application (*See* 2nd Seeman Decl. and Henson Decl.)

The critical period for diligence for a first conceiver (Applicant here) but the second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice. *Hull v. Davenport*, 90f.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937). Further, an applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363f.2d 908, 919, 150 USPQ 634, 643 (CCPA 1996). The diligence of an attorney in preparing and filing a patent application inures to the benefit of the inventor. Reasonable diligence is established if an attorney worked reasonably hard on the application during the continuous critical period. “It is of no moment that the end of that period [for diligence] is fixed by a constructive, rather than an actual, reduction to practice.” *Justus v. Appenzeller*, 177 USPQ 332, 340-341 (Bd. Pat. Inter 1971).

With the above guidelines in mind, the collective evidence needs to establish a conception of the invention prior to the priority date of the Lazareck reference (February 7, 2003), coupled with due diligence from a point in time just before this date until Applicant's constructive reduction to practice which occurred when the provisional application was filed on April 17, 2003. It is respectfully submitted that there is ample evidence to establish this. As noted above, the previous reply quite clearly established conception prior to February 7, 2003.

The newly offered declarations clearly establish that the earlier conception was coupled with due diligence during the relevant period. In particular, the Henson Decl. sets forth that the undersigned was the patent attorney for the applicant during this period while at the firm Timothy J. Martin P.C. in Lakewood, Colorado. Mr. Henson states that he began working on the provisional application, from which the present application claims the benefit, in late 2002 and early 2003. This work was regular and continuous under the circumstances from just prior to February 7, 2003 through at least about March 11, 2003. Following the client's review of the draft provisional application, Mr. Henson was diligent in finalizing and filing the application by April 17, 2003.

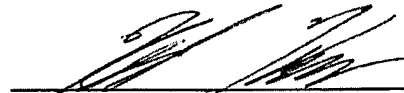
Attached respectively as Exhs. A and B to the Henson Decl. are the firm's billing invoices to the applicant for the months of March and April 2003. From these invoices, and as more fully set forth in the Henson Decl., it is clear that Mr. Henson's efforts in preparing the application were reasonably hard and ongoing throughout this period. This is evidenced by the numerous date entries where Mr. Henson was either working on the draft of the application or communicating with client representatives, each of which is quite ordinary under the circumstances. In addition, the 2nd Seeman Decl. shows that the

inventors were also diligent during the critical period between February 7, 2003 and April 17, 2003. In particular, Mr. Seeman explains that the inventors were scattered throughout the country and that it necessarily took some time under the circumstances to coordinate their review of the application and provide their collective comments and feedback to Mr. Henson. During the period, the inventors would exchange e-mails and have weekly telephone conferences.

All of the evidence which is now before the Examiner, namely, the 1st and 2nd Seeman Decls. and the Henson Decl., conclusively demonstrate both a conception of the invention prior to the effective date of Lazareck (February 7, 2003) coupled with diligence from prior to Lazareck's effective date to the filing date of this application's priority document (April 17, 2003). Accordingly, it is respectfully submitted that the rejections of the pending claims based on Lazareck, MS Word and Nara are hereby obviated.

Based on the foregoing, Applicant submits that the present application is in complete condition for allowance, and action to that end is courteously solicited. If any issues remain to be resolved prior to the granting of this application, the Examiner is requested to contact the undersigned attorney for the applicant at the telephone number listed below.

Respectfully submitted,



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